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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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3M INNOVATIVE PROPERTIES COMPANY			EXAMINER	
PO BOX 33427			SIMONE, CATHERINE A	
ST. PAUL, MN 55133-3427				
			ART UNIT	PAPER NUMBER
			1794	
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			01/27/2009 ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

**Application No.**

09/974,710

**Applicant(s)**

FLANIGAN ET AL.

**Examiner**

Catherine Simone

**Art Unit**

1794

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7,10-17,19-22,26,28-53 and 55-60 is/are pending in the application.
- 4a) Of the above claim(s) 36-53 and 55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,10-17,19-22,26,28-35 and 56-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/11/2008 has been entered.

***Withdrawn Rejections***

2. The 35 U.S.C. 112, second paragraph, rejections of claims 1, 3-8, 10-17, 19-21, 28-35 and 56-60 of record in the Final Office Action mailed 6/13/2008 have been withdrawn due to the Applicant's amendment filed 9/11/2008.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 11, 13, 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed

invention. Claim 11, which depends from claim 1, recites “the article comprises a plurality of channels”. However, claim 1 recites “the article comprises discrete, encapsulated reservoirs”. Thus, Applicants are claiming an article comprising discrete, encapsulated reservoirs and a plurality of channels. However, the Specification, as originally filed, does not provide support for an article having both discrete, encapsulated reservoirs and a plurality of channels. The Specification provides support for an article having either reservoirs or channels, not both. Specifically, on page 7, lines 9-11 of the Specification, Applicants have support for an article having a plurality of discrete reservoirs or channels. The Specification, as originally filed, does not provide support for an article having both reservoirs and channels, as presently claimed in claims 1 and 11. Accordingly, claims 1 and 11 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 4, 6, 7, 11, 13, 16, 17, 19, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Mann (US 2,638,430).

Regarding claim 1, Mann discloses an article (*surface covering, title*) comprising at least one adhesive layer (*col. 5, line 51*) with a first major surface and a second major surface (*figures*

2 and 3), wherein at least one of the first and second major surfaces is a structured surface (*col. 5, lines 74-75*), and a backing (*col. 5, lines 53-55*) directly adjacent to the structured surface(s) of the at least one adhesive layer (*figure 3*), wherein both surfaces of the backing are non-structured (*figure 3*). The article comprises discrete, encapsulated reservoirs (*col. 5, lines 74-75 and col. 6, lines 12-15*) between the structured surface of the at least one adhesive layer and the backing (*figures 2 and 3*). The article has a non-structured exposed adhesive surface that can be adhered to a target substrate, since the non-structured side of the adhesive has a release paper on it that permits removal during installation (*col. 5, lines 45-40*).

Regarding claims 3 and 4, Mann discloses that the adhesive layer is a pressure sensitive adhesive selected from the group consisting of acrylics, natural and synthetic rubbers, ethylene vinyl acetate, vinyl ethers, silicones, poly(alpha olefins), and combinations thereof (*col. 2, lines 1-2 and col. 5, lines 30-40*).

Regarding claim 6, Mann discloses an additional adhesive layer having a non-structured surface (*figures 2 and 3, layer 35*).

Regarding claim 7, Mann discloses at least one non-adhesive layer in contact with one of the first and second major surfaces (*col. 5, lines 45-50 and figures 2 and 3*).

Regarding claim 11, Mann discloses the article comprising a plurality of channels (*col. 5, lines 45-50*).

Regarding claims 13, 16 and 17, Mann discloses that reservoirs/channels contain at least one deliverable or non-deliverable vibration-damping fluid substance (*air, figures 2 and 3*).

Regarding claim 19, Mann discloses the backing is a laminate (*figures 2 and 3*).

Regarding claim 20, Mann discloses the second major surface is a non-structured surface, the backing contacts the first major surface, and wherein the article further comprises a backing layer on the second major surface (*col. 5, lines 45-50*).

Regarding claim 21, Mann discloses the second major surface of the at least one adhesive layer being a structured surface, the backing contacts the first major surface, and wherein the article further comprises a backing layer on the second major surface (*figure 3*).

7. Claims 1, 3, 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hata (JP 11-181367, newly cited).

Regarding claim 1, Hata discloses an article (window glass structure) comprising at least one adhesive layer (*Drawings 1, 3 and 4, layer 10*) with a first major surface and a second major surface (*Drawings 1, 3 and 4*), wherein at least one of the first and second major surfaces is a structured surface (*Drawings 1, 3 and 4, surface 2*), and a backing (*Drawings 3 and 4, backing 31*) directly adjacent to the structured surface of the at least one adhesive layer, wherein both surfaces of the backing are non-structured (*Drawings 3 and 4, backing 31*). The article comprises discrete, encapsulated reservoirs (*Drawings 1, 3 and 4, reservoirs 3*) between the structured surface of the at least one adhesive layer and the backing. The article has a non-structured exposed adhesive surface that can be adhered to a target substrate (*Drawing 3*).

Regarding claims 3 and 4, Hata discloses that the adhesive layer is a pressure sensitive adhesive selected from the group consisting of acrylics, natural and synthetic rubbers, ethylene vinyl acetate, vinyl ethers, silicones, poly(alpha olefins), and combinations thereof (*paragraphs 0023 and 0031-0033*).

Regarding claim 7, Hata discloses at least one non-adhesive layer in contact with one of the first and second major surfaces (*Drawing 4, layer 32 and paragraph 0023*).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5, 10, 12, 14, 15, 22, 26 and 56-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann (US 2,638,430).

Regarding claims 5, 10, 22, 26, 56 and 57, Mann is relied upon as described above.

Mann fails to disclose the claimed peel strength, the claimed thickness of the tape or the claimed volume of the voids/reservoir/channels.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the peel strength, the thickness of the tape or the volume of the voids/reservoir/channels in Mann to have the claimed ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

Regarding claims 12, 14, 15 and 58-60, Mann discloses that reservoirs/channels contain at least one deliverable or non-deliverable vibration-damping fluid substance (*air, figures 2 and 3*).

10. Claims 5, 10, 12, 14, 15, 22, 26 and 56-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hata (JP 11-181367)

Regarding claims 5, 10, 22, 26, 56 and 57, Hata is relied upon as described above.

Hata fails to disclose the claimed peel strength, the claimed thickness of the tape or the claimed volume of the reservoirs.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the peel strength, the thickness of the tape or the volume of the reservoirs in Hata to have the claimed ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

Regarding claims 12, 14, 15 and 58-60, Hata discloses reservoirs that contain at least one deliverable or non-deliverable vibration-damping fluid substance (*air, paragraph 0021*).

11. Claims 6, 20, 21 and 28-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hata (JP 11-181367) in view of Hata (WO 97/33946).

Hata (JP 11-181367) teaches the claimed article as described above.

Hata (JP 11-181367) fails to teach a second adhesive layer having a first major surface and a second major surface wherein at least one of the first and second major surfaces is a structured surface, wherein the at least one adhesive layer and the second adhesive layer are in contact; and the first major surface of the first adhesive layer being a structured surface and the



second major surface of the first adhesive layer being a non-structured adhesive surface, and the first major surface of the second adhesive layer being a structured surface and the second major surface of the second adhesive layer being a non-structured surface, and the second major surface of the first adhesive layer contacting the first major surface of the second adhesive layer.

Hata (WO 97/33946) teaches an adhesive sheet having first and second adhesive layers (Fig. 3a), wherein the second adhesive layer has a first major surface and a second major surface and at least one of the first and second major surfaces is a structured surface, and the first adhesive layer and the second adhesive layer are in contact, and the first major surface of the first adhesive layer is a structured surface and the second major surface of the first adhesive layer is a non-structured adhesive surface, and the first major surface of the second adhesive layer is a structured surface and the second major surface of the second adhesive layer is a non-structured surface, and the second major surface of the first adhesive layer contacts the first major surface of the second adhesive layer for the purpose of providing a multi-layered adhesive sheet that can absorb, subside or release an external action such as impact, vibration (including sound), heat etc. (page 3, lines 6-7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the structure in Hata (JP 11-181367) with a two-layered adhesive sheet instead of one layer of adhesive wherein the second adhesive layer has a first major surface and a second major surface and at least one of the first and second major surfaces is a structured surface, and have the first adhesive layer and the second adhesive layer be in contact, and the first major surface of the first adhesive layer being a structured surface and the second major surface of the first adhesive layer being a non-structured adhesive surface, and the first major

surface of the second adhesive layer being a structured surface and the second major surface of the second adhesive layer being a non-structured surface, and have the second major surface of the first adhesive layer contacting the first major surface of the second adhesive layer as suggested by Hata (WO 97/33946) in order to form a multi-layer adhesive structure providing improved heat-insulating, soundproofing, and vibrationproofing effects.

***Response to Arguments***

12. Applicant's arguments regarding the 35 U.S.C 112, second paragraph, rejections of record in the Final Office Action mailed 6/13/2008 have been considered but are moot, since the rejections have been hereby withdrawn due to the Applicant's amendment filed 9/11/2008.

13. Applicant's arguments filed 9/11/2008 regarding the 35 U.S.C. 102 and 103 rejections over Mann have been fully considered but they are not persuasive.

14. Applicant argues that Mann does not teach "discrete, encapsulated reservoirs" as defined in claim 1.

15. The Examiner disagrees. Again, as seen in figure 3, when tile (29) is placed on top of the structured surface of the adhesive it creates the "discrete, encapsulated reservoirs" between the structured surface of the adhesive and the backing as claimed. Furthermore, it is to be pointed out that Mann teaches the grooves 42 in Fig. 3 of the adhesive layer 21 are enclosed pockets when the tile (29) is placed on top of the structured adhesive. Thus, Mann clearly teaches discrete, encapsulated reservoirs between the structured surface of the adhesive layer and the backing as claimed. Again, the fact that air can escape is irrelevant, since Applicant is not claiming completely sealed or completely encapsulated reservoirs.

***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571) 272-1501. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 1794

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